

9847-0001-6X PCT  
ENKEL 8025

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
MATS LEIJON, et al. : EXAMINER:  
SERIAL NO. : 09/147,325 :  
FILED: February 17,1999 : GROUP ART UNIT: 2834  
FOR: ROTATING ELECTRICAL :  
MACHINE COMPRISING HIGH-VOLTAGE  
STATOR WINDING AND ELONGATED  
SUPPORT DEVICES SUPPORTING THE  
WINDING AND METHOD FOR  
MANUFACTURING SUCH MACHINE

LETTER

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Applicants in the above-identified patent application wish to make of record the references listed on the enclosed "Alternate Form PTO 1449" and the related co-pending applications listed on the enclosed "List of Related Cases" filed herewith and as described in the enclosed Petition Under 37 C.F.R. §1.182, also filed herewith.

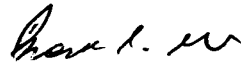
The Petition requests that all the cited references in the present Information Disclosure Statement be considered both for the above-identified patent application as well as the related applications. One paper copy of the references has already been provided to SPE Nestor Ramirez, and two additional copies are filed herewith. A copy of the "Electronic Search Tool" will be filed once the undersigned are notified that the Petition has been granted. The electronic search tool contains foreign search reports which serve as statement

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WASHINGTON, D.C. 20535

of relevancy for foreign language references, and also provides, where available, English translations or partial translations of non-English language references, where available.

Respectfully submitted,

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PETITION UNDER 37 C.F.R. §1.182

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Applicants, the Assignee, and Applicants' Patent Counsel in the above-identified patent application, and other related applications that together form "the bulk filing applications," hereby petition the Commissioner of the U.S. Patent and Trademark Office (hereinafter "the Office") to expressly agree to the below-described procedures to be followed by Applicants, Assignee, and Applicants' Patent Counsel in meeting respective duties and obligations imposed by 37 C.F.R. §1.56 for the bulk filing applications.

## 1.0 BACKGROUND

### 1.1 Bulk Filing Applications

As part of the ENKEL<sup>1</sup> program, the Assignee, Asea Brown Boveri (ABB) AB, is aggressively developing a worldwide patent portfolio on what the Assignee believes is a revolutionary breakthrough in high-voltage devices, systems and methods. Over the next two years or so, the Assignee will file the remaining portion of the bulk filing applications, which will ultimately amount to over 200 U.S. patent applications. The Assignee is also pursuing similar filing strategies in roughly 40 other countries with corresponding numbers of patents. Thus, globally the ENKEL program will manage a coordinated effort to obtain several thousand patents in next few years.

### 1.2 Duty of Disclosure Requirements Under Existing Rules

Consistent with the duties imposed by 37 C.F.R. §1.56, U.S. patent Rules<sup>2</sup> require practitioners to file Information Disclosure Statements (IDS) that list each reference submitted for consideration during examination and include paper copies of the listed references. These references include references found by foreign Examiners who are examining corresponding foreign applications<sup>3</sup>, as well as references identified by U.S. Examiners for co-pending U.S. applications having related subject matter<sup>4</sup>. Accordingly, for any one of the bulk filing applications, there will likely be over 200 U.S. cases that have

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<sup>1</sup>ENKEL is Swedish for “simple”, which is descriptive of how the technology disclosed in the bulk filing applications will greatly simplify next-generation power system equipment.

<sup>2</sup>See, 37 C.F.R. §1.97 and §1.98.

<sup>3</sup>MPEP §2001.06(a)

<sup>4</sup>MPEP §2001.06(b)

some related subject matter, and each of these 200 or more cases will have as many as 40 corresponding foreign applications.

Given the unusually large number of related U.S. cases and corresponding foreign applications, the conventional approach of filing a separate Form 1449 form with attached references for each application every time a new reference has been found by an Examiner (foreign or U.S.) in a related case (foreign corresponding application or related U.S. application) will be burdensome for the Assignee, as well as for the U.S. Examiners. Nonetheless, providing the Office with this amount of information is believed to be in the Assignee's best interest because it is recognized that it is the U.S. Examiner who makes the decision regarding what is "material" to the patentability of the claimed invention, not the Applicant or Assignee. MPEP §2001.05 appears to endorse this position by explaining the following:

[t]he Office believes that most applicants will wish to submit the information, however, even though they may not be required to do so, to strengthen the patent and avoid the risks of an incorrect judgment on their part on materiality or that it may be held that there was an intent to deceive the Office.

Accordingly, to avoid the risk of later having one, or all, of the bulk filing applications be held unenforceable, the Assignee believes it is in the Assignee's best interest to present the Office with all the references identified by foreign and US Examiners in regard to any of the bulk filing applications or corresponding foreign applications. As a consequence, the Assignee recognizes that the conventional approach of providing separate copies of references for each of the bulk filing application, any time a new reference is discovered in another one of the ENKEL applications, is neither practical nor efficient for the Office, or for the Assignee.

### 1.3 Availability Of Electronic Search Tool

As a tool for internal management, the Assignee has developed and regularly updates an electronic search tool, which includes a searchable database, to keep track of the various U.S. and foreign patent applications for the ENKEL program. The database is updated to include (1) electronic copies of newly received foreign search reports, (2) new references cited by U.S. and foreign examiners, (3) copies of newly filed applications, including patent claims, and (4) other papers recently filed in the respective applications. The electronic search tool allows for cross-referencing of references, efficient searching in the references, and convenient comparison of claims for the bulk filing applications, primarily for double patenting determinations.

The electronic search tool is implemented on a personal computer using LotusNotes™ software. Thus, the electronic search tool may be easily operated on one of the Office's computers, provided that computer is equipped to run LotusNotes™. One method of updating the search tool is by way of a compact disc (CD-ROM) that includes an updated version of the database used on the search tool. Presently, one CD-ROM is sufficient to hold the entire database.

### 1.4 Coordination With USPTO Personnel

The undersigned, selected USPTO personnel, as well as others listed on the attached June 4, 1999 "ENKEL Project Meeting" listing have met on several occasions to discuss possible ways for most efficiently handling IDS information by providing the Office with updated copies of the search tool. During the meetings it was determined that while the electronic search tool would likely be quite helpful for examination purposes, the Code Of Federal Regulations ("the Rules") does not presently provide for the Applicants, Assignee of

the subject application, and Applicants' Patent Counsel to meet their respective duty of disclosure requirements by providing the USPTO with an electronic search tool, by itself or with other supporting materials.

## 2.0 QUESTIONS NOT SPECIFICALLY PROVIDED FOR

Rule 182 allows interested parties to petition the Commissioner to decide situations not specifically provided for in the Regulations. The problems imposed by following conventional IDS practice for the present bulk filing situation and opportunities made possible by the availability of Assignee's proprietary electronic search tool, gives rise to the following two questions<sup>5</sup>, which are now presented as the questions to be decided for the present petition:

### QUESTION 1: DUTY OF DISCLOSURE COMPLIANCE

Whether the information cited in the manner proposed in Section 3.1.1 herein (including the filing of paper copies in only one case and submission of an electronic search tool) is a disclosure that is sufficient to meet the requirements of 37 C.F.R. §1.56?

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<sup>5</sup> These questions may not be decided independent of one another since the Electronic search tool will include electronic copies of foreign search reports, which serve as a concise explanation for why certain foreign references have been filed. Nonetheless, the Assignee perceives that the combination of filing three sets of IDS information for the entire set of bulk filing applications along with the use of the electronic search tool when searching provides the most complete solution to the duty of disclosure issues raised by filing such a large number of related applications. In particular, the electronic search tool provides a convenient tool for searching through the large number of references that will be filed in the bulk filing applications.

## QUESTION 2: PROTECTING CONFIDENTIALITY OF ASSIGNEE'S WORLDWIDE PATENTING STRATEGY

Will the Assignee's expressed interest in retaining legal ownership to the electronic search tool provided to the Office under the terms of a license agreement ("Proprietary Electronic Search Tool Agreement") protect the Assignee from the Office later releasing the electronic search tool to a third party without the consent of the Assignee?

### 3.0 DISCUSSION OF QUESTIONS

#### 3.1 QUESTION 1: DUTY OF DISCLOSURE COMPLIANCE:

##### 3.1.1 PROPOSED PROCEDURES

##### 3.1.1.1 APPLICANTS TO FILE THREE COPIES OF EACH REFERENCE

US application, Serial No. 09/147,325, entitled "ROTATING ELECTRICAL MACHINE COMPRISING HIGH-VOLTAGE STATOR WINDING AND ELONGATED SUPPORT DEVICES SUPPORTING THE WINDING AND METHOD FOR MANUFACTURING SUCH MACHINE" will serve as a "holding case" for all references submitted to the Office for consideration in all of the bulk filing applications, consistent with 35 U.S.C. §1.56. Initially, three sets of all the references included in the electronic search tool will be filed in US application, Serial No. 09/147,325. The Office will use the first set as a master file, in the event copies of the references in the other two sets are lost or made unavailable at some time in the future. A second set of references will be used by the Office to populate new subclasses of references associated with the subject matter of the bulk-filing applications. The new subclasses will initially contain only references submitted by the Assignee, but will later be supplemented by the Examiners during the normal course of



examination of the bulk filing applications as well as other applications filed by others. A third set of references will remain with US application, Serial No. 09/147,325. If U.S. application, Serial No. 09/147,325 is allowed, the Assignee will file a Rule 1.103 Petition to Suspend Action so that U.S. application, Serial No. 09/147,325 may remain the holding case. The Assignee will reserve the right to file a continuation application so as to obtain patent coverage on the allowed claims. Alternatively, if both the Assignee and a Director of Technical Center 2800 agree, an alternate holding case may be designated.

3.1.1.2 LIST ALL REFERENCES ON A FORM 1449 (OR EQUIVALENT) IN EACH APPLICATION

Applicants will initially submit in each bulk-filing application a Form 1449 (or an equivalent), listing all references previously submitted in any of the other bulk filing applications as well as any new references. When new references are identified for a particular bulk filing application, those references will be provided in the form of three copies and the new references will be appended to the other references already cited in the Form 1449 (or equivalent). Accordingly, consistent with MPEP §2002.02, which requires that disclosures under Rule 56 be made in writing, each of the references to be considered in each case will be identified in writing on a Form 1449 (or an equivalent). Furthermore, three copies of that reference will be filed in US application, Serial No. 09/147,325, as will a copy of a decision that results from the present petition, provided the decision is favorable.

Due to the large number of foreign corresponding patent applications, the Assignee expects to receive for several years a continuing stream of newly found references. For procedural simplicity, the Assignee will file the newly found references (three copies) in

monthly installments in the holding case and will file separate Form 1449's (or equivalent) each month in all of the bulk filing applications. The monthly installments will be filed within the timeliness requirements of 37 C.F.R. §1.97. Accordingly, at the end of each month, each of the pending bulk filing applications, except those that have been finally rejected or allowed, as discussed below, will have a complete set of Form 1449's (or equivalent) for the respective Examiners to initial after the Examiners have considered the references listed thereon.

After a case has been finally rejected or allowed, the monthly installment of new references, listed on a Form 1449 (or equivalent), may be considered at the Examiner's discretion, but the Examiner is not required to consider the references unless the Assignee files a petition with the required fee and a certification to have the references considered.

#### 3.1.1.3 EXAMINERS REQUIRED TO SEARCH NEW SUBCLASSES

As the newly created subclasses will include a complete set of references that have been identified by Applications, foreign examiners and fellow U.S. Examiners, the U.S. Examiners will be required to search the newly created subclasses as part of the routine patent prosecution process. This will ensure the Examiners will consider references identified by other persons familiar with related cases, and thus may help streamline the searching process when the Examiner performs his or her own search.

#### 3.1.1.4 LICENSING OF ELECTRONIC SEARCH TOOL

The present Assignee has developed for its own use a search tool with a database that contains a comprehensive and organized arrangement of the bulk-filing applications, foreign

counterpart applications, and prior art references asserted against the bulk-filing applications and corresponding foreign applications. This electronic search tool is transportable from computer to computer since it is hosted on a computer readable media, presently a compact disk, and runs on standard LotusNotes™ software stored on the host computer. The electronic search tool contains all the references previously filed in triplicate hard-copy format in the holding case.

In the interest of obtaining a strong patent portfolio that results from a thorough search of the prior art, the Assignee has offered to the Office the Assignee's electronic search tool. More particularly, the Assignee would like to grant to the Office a royalty-free license to use the electronic search tool. A copy of the license agreement is filed herewith. Each month, the Assignee will provide to the Office one or more CD-ROMs, or other mutually agreeable computer readable media, where each new CD-ROM will contain all of the information provided in the past CD-ROMs, as well as updated information. Furthermore, each new CD-ROM will include a date-added search feature that will allow Examiners to determine newly added references from previously presented references. This search feature should assist Examiners in performing supplemental searches. In the event no additional information has been added to the electronic search tool during a given month, the Assignee may optionally provide to the USPTO a new CD-ROM.

The contents of the electronic search tool will include the contents of each of the bulk-filing applications, linking information between each of the bulk-filing applications and corresponding foreign applications, search reports and references identified by foreign patent examiners (including "X references" and "Y references") and translations, if available, for the corresponding references. The foreign search reports and designation of references as

being "X" and "Y" references, both of which will be contained in the electronic search tool, will serve as a concise explanation of the relevance of foreign references. The electronic search tool is hosted on LotusNotes™ software, and provides a relatively simple way for Applicants as well as the Examiners to identify references that may be deemed material to the patentability of the various inventions claimed in the bulk-filing applications. Furthermore, the electronic search tool provides arguments presented by foreign examiners in a format that is quickly and easily presented for any particular case of interest. The electronic search tool will also include claims of the different bulk filing applications, and will group applications by functional subject matter and by parent-child lineage, thus assisting the Examiners in making double-patenting determinations.

The Examiners may make hard copy printouts of whatever information is deemed relevant by the Examiners when considering the patentability of the claims in the application. These hard copy printouts will be included in the file and will be part of the public record when that particular patent application issues as a patent.

The Assignee and the USPTO (by way of a Director of Technology Center 2800, or another person of at least equivalent authority) retain the mutual option to terminate the proposed procedures if the present petition is granted. Terminating the proposed procedures may avoid compelling the Assignee or the USPTO to continue with the procedures if the procedures become too burdensome to follow, particularly if it would be less of a burden to follow conventional IDS procedures. In order to provide adequate notice to the Assignee or USPTO, the Assignee and USPTO will begin to follow conventional IDS procedures 3 months after written notice is made to the Assignee (by way of the Attorney of Record) or the

Assignee files the termination request in the holding case and contacts a Director of TC 2800 by telephone.

3.1.2 PROPOSED PROCEDURES COMPLY WITH SCOPE AND SPIRIT OF DUTY OF DISCLOSURE REQUIREMENTS

Consistent with Rules 1.97 and 1.98, it is believed that Applicants comply with their Rule 56 duty of disclosure regarding the filing of IDSs by including in the IDS the following:

(1) a list of all patents, publications or other information submitted for consideration by the Office;

(2) a legible copy of

(i) each U.S. and foreign patent,

(ii) each publication or portion which has caused to be listed, and

(iii) all other information or portion which has caused it to be listed, except that no copy of a U.S. patent application need to be included; and

(3) a concise explanation of the relevance of each patent, publication or other information listed that is not in the English language.

The proposed procedures expressly comply with Rule 98(a) (1), since a Form 1449, or equivalent listing in each case all patents, publications or other information submitted for consideration by the Office. The proposed procedures also expressly comply with Rule 98(a)(2) since Applicants will in fact be providing a legible copy of each listed reference<sup>6</sup>.

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<sup>6</sup>Actually, Applicants will be filing three sets of all references, although not separate sets in each case.

With regard to Rule 98(a)(2)(iii), a "legible copy" of foreign search reports for example will be provided by way of the electronic search tool and a copy may be generated by the Examiner if anything in the foreign search report itself is deemed to be relevant, and perhaps material, to the patentability of the presently claimed invention. With regard to Rule 98(a)(3), the electronic search tool provides the "linkage" between the U.S. patent application under consideration and any of the cited references. Furthermore, the electronic search tool makes available in a convenient fashion each cited reference, any foreign search report that cites the reference, and any translations, to the extent the translations are available. The electronic search tool offers a convenient mechanism for identifying foreign search reports cited against foreign counterpart applications, and provides hypertext links to images of the references cited in the foreign search reports.

It is respectfully submitted that by filing a Form 1449 (or equivalent) listing each of the references included in the electronic search tool, filing three copies of each reference in a related case, (i.e., U.S. Serial No. 09/147,325), filing monthly installments of newly found references and Form 1449s (or equivalents) with an updated electronic search tool, and providing a computer searchable mechanism for all of the references, that Applicants will expressly comply with the disclosure duties of Rule 56 and will have complied with the spirit and scope of Rules 97 and 98.

With regard to related case statements, M.P.E.P. §2001.06(b) recognizes that Applicants have an obligation to bring to the attention of the Examiner other applications that may have similar subject matter as the pending application. Consistent with this obligation, Applicants submit that the respective bulk filing applications contain some overlapping subject matter. The electronic search tool offers a mechanism by which the Examiner may

quickly identify the identities of the other bulk filing applications, and may quickly compare the claims of the bulk filing applications when considering double patenting rejections.

### 3.1.3. COMPARISON: CONVENTIONAL VS. PROPOSED PROCEDURES

Consistent with the Assignee's assessment of the need to disclose to the Office any reference that might ultimately be determined as being material to the patentability of a claimed invention, MPEP §2001.05 endorses the solution presented herein, namely providing all of the references to the Office:

[t]he Office believes that most applicants will wish to submit the information, however, even though they may not be required to do so, to strengthen the patent and avoid the risks of an incorrect judgment on their part on materiality or that it may be held that there was an intent to deceive the Office.

However, regarding how to implement the Assignee's plan to submit all the potentially-material references, following the conventional approach of filing separate copies of references in order to encompass the prior art found by foreign examiners and fellow U.S. Examiners for corresponding and related cases, would amount to filing the equivalent of the new subclasses of references in each of the 200 or more U.S. cases. Considering the paper management issue that this approach would raise, each Examiner will be faced with the same problem that the present Assignee was faced with before developing the electronic search tool: a huge volume material that is very difficult to manage and review in an efficient manner. Given the magnitude of expected volume of material, and in light of the fact that Applicants have already prepared the electronic search tool, it is believed that the proposed procedures present an opportunity for the Office and the Assignee to work cooperatively to provide for a thorough, and efficient examination process, without jeopardizing the public's

interest in having the Office issue valid, enforceable patents with a public record that includes all the information considered by the Examiners in each case.

### 3.2 QUESTION 2: PROTECTING CONFIDENTIALITY INFORMATION

While the electronic search tool would appear to benefit the Office, the Applicant, and the public,<sup>7</sup> to accomplish its objective the electronic search tool necessarily contains more than what is required to comply with duty of disclosure requirements. In particular, the electronic search tool the Assignee's worldwide patent strategy in a distilled form, the release of which to third parties would jeopardize the Assignee's rightful interest in seeking unfettered worldwide patent protection on this important technology. The Assignee considers the following subject matter in the electronic search tool to be confidential, and thus not to be released to others outside of the Office:

- (1) The volume of filings in the United States, as well as in foreign countries;
- (2) The specific countries in which Applicants are seeking patent protection;
- (3) The identification of related U.S. co-pending applications or any thing, such as status information, that may be gleaned from being informed of an existing of co-pending U.S. patent applications, which has not already been released to the public. As a practical matter, the Assignee views it as being too burdensome and prone to error for the Assignee to provide a redacted copy of the search tool for use by the Office, or for later release to the

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<sup>7</sup>The public has an interest in having the Office issue valid, enforceable patents. The electronic search tool is believed to assist the Office in satisfying the public's interest by assisting the Office issue patents that have been carefully screened against all prior art that is known to be potentially material to the claimed invention.



public, especially since the nature of the confidential material is not particular phrases, but rather the scope and content of the Assignee's patent portfolio for the inventive technology.

The Assignee does not object to Examiners making hard copy printouts of anything in the electronic search tool for inclusion in file that is being examined by the Examiner. However, the present Assignee does not consent to making the entire electronic search tool available to the public.

The possibility exists that a member of the public will request a copy of the electronic search tool under a Freedom of Information Act (FOIA) request, or when learning from an issued application's file wrapper that the Examiner used an electronic search tool during patent prosecution. So as to avoid having the Office be legally compelled to release the electronic search tool and solely defend the Assignee's proprietary interest in the electronic search tool, the Assignee will retain legal ownership of the electronic search tool and will grant to the Office a license, filed herewith, to use the electronic search tool for examining the bulk-filing applications. On a monthly basis, as long as a change in the electronic search tool has taken place during that month, the Assignee extends the license grant to the Office for a new CD-ROM with updated information, and retrieve from the Office, last-month's CD-ROM.

A licensing agreement is filed herewith, the basic terms of which include:

(1) Assignee retains ownership, and USPTO obtains license to use the CD-ROM, including the right to make hard copy printouts for inclusion in patent application files of any subject matter contained within the electronic search tool; and

(2) The Office may not provide the electronic search tool, or a full or partial copy thereof, to any third party regardless if the third party submits a FOIA request, or when requesting to review a file of one of the bulk-filing applications that has issued as a patent.<sup>8</sup>

### 3.2.1 STATUTORY AND REGULATOR PROTECTION OF ASSIGNEE'S CONFIDENTIAL INFORMATION

35 U.S.C. §122 requires the Office to keep in confidence applications for patents and information concerning applications for patents. Thus, even though the electronic search tool hosts the application data in a computer readable media form, the information nonetheless contains the number of corresponding U.S. applications (and foreign applications), which under 35 U.S.C. §122 must be protected as being confidential information.

Rule 1.14 (a) amplifies the Office's duty to keep such information relating to applications confidential by prohibiting the Office to provide information concerning the filing, pendency, or subject matter of any application for patent, all of which will be contained in the electronic database. Even if a member of the public becomes aware of a pending application, perhaps by way of a reference to that application in an issued patent, that person may still request status information from the Office, and the Office may properly provide the person with status information without granting the person access to the electronic search tool.

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<sup>8</sup>Much as if the Assignee were to grant a license to a commercial entity, the Assignee would expect that the license agreement would reserve a legal right for the Assignee to defend the Assignee's confidential material from being distributed to a third party if the third party requests the Office provide its licensed copy of the electronic search tool to the third party. The license agreement includes a provision that requires the Office to notify the Assignee within 10 working days of a FOIA request. This should be ample time since the Office is obliged under 5 U.S.C. §552a6Ai to respond to the request within 20 working days.

The issue presented by receiving the electronic search tool is related in some aspects to how the Office treats “interference search” information, which is held confidential by the Office and made available only to Office personnel.<sup>9</sup> Much like conveniences associated with keeping the book of “Prospective Interferences”, the electronic search tool also provides certain conveniences to Office personnel and contains information on possible overlapping subject matter for multiple co-pending applications that should be held confidential.

The Assignee still holds the information in the electronic search tool as being confidential, even if Examiners use the search tool for examining applications of third parties. For example, suppose an Examiner makes a note on the file jacket of a third party’s application indicating that the Examiner used the search tool to search for prior art applied against the third party’s application. Under this scenario, as with all other scenarios, the Assignee regards the contents of the electronic search tool to be confidential, and would expect the Office not to release the electronic search tool to the third party, if the third party requested as much. The existence of the electronic search tool is not confidential, but rather its contents are what is confidential.

### 3.2.3 REQUESTS UNDER FREEDOM OF INFORMATION ACT

The Assignee recognizes that under FOIA members of the public generally have a right to access federal agency records, unless exempted or excluded by law.<sup>10</sup> Consistent

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<sup>9</sup>MPEP 2301.01(b) explains that Examiners should perform an interference search before issuing a case and when a potential interference exists, recording relevant data in a book of “Prospective Interferences”. However, the Examiners should not make any notations that may provide an applicant with a “hint” of the supposedly interfering application.

<sup>10</sup> There is extensive case law interpreting the FOIA and the present discussion does not intend to address all the relevant issues. Furthermore, FOIA is an area of law that is generally

with 35 U.S.C. §122, which protects the confidential status of pending applications, Exemption 3 in FOIA provides a statutory basis for the Office to refrain from providing the electronic search tool in reply to a FOIA request since the electronic search tool holds status information for many pending application<sup>11</sup>. Exemption 4 in FOIA provides an alternative basis for having the Office refrain from releasing the electronic search tool in reply to a FOIA request because the Assignee considers the entire contents of the electronic search tool to contain proprietary information.<sup>12</sup> The subject matter contained in the electronic search tool would be particularly harmful to the Assignee's competitive position because it provides a blueprint regarding which countries the Assignee is seeking patent coverage, but more importantly, which countries the Assignee is not seeking patent protection. For example, by knowing the magnitude of Assignee's filings and where the Assignee is filing most of the applications, a competitor may identify "holes" in geographical areas not covered by patent protection and thus suitable to establish a manufacturing plant, that would otherwise constitute an infringing activity if patent protection were available. Thus, release of the electronic search tool by the Office would result in substantial harm to the Assignee's competitive position in the worldwide power system market.

#### 4.0 OFFICIAL GAZETTE NOTIFICATION

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outside the undersigned's area of specialty, and much of the discussion and case law presented herein was provided to the undersigned by Office personnel who are more familiar with FOIA than the undersigned.

<sup>11</sup>This exemption is referred to as "Exemption 3" as explained in the JUSTICE DEPT. GUIDE TO THE FREEDOM OF INFORMATION ACT, SEPT 1998.

<sup>12</sup>This exemption is referred to as "Exemption 4" as explained in the JUSTICE DEPT. GUIDE TO THE FREEDOM OF INFORMATION ACT, SEPT 1998.

This petition raises two new questions regarding the use of electronic search tools for bulk filings that are not specifically provided for in the patent Regulations. Because, the procedures proposed herein may result in new rules and procedures for handling similar situations, the undersigned recognizes that it may be necessary and beneficial to receive the public's comments before adopting the proposed procedures for other situations. The proposed procedures set forth herein are the result of several cooperative discussions held between the Assignee, counsel for the Assignee, and various members of the Office, as indicated on the list appended hereto. While the proposed procedures are acceptable to the present Assignee, similar procedures may not be acceptable to other Assignees in future situations. Accordingly, the present Assignee is not opposed to the Office publishing a notice in the Official Gazette explaining the present experimental procedure being carried out for the present bulk filing. The Assignee does, however, request that neither the Assignee nor the technology be specifically identified in the published notification.

#### 5.0 CONCLUSION

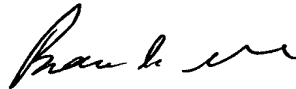
In light of the present facts and circumstances and in view of the above discussion, the Applicants, the Assignee, and the undersigned respectively request that the present

petition to address the questions raised herein be granted by formally adopting the procedures proposed herein for the subject bulk filing. The required fee as required under §1.17(i) for the present petition of **\$130.00** is enclosed.

In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted document, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

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